

Appl. No.: 09/913,378  
Response dated Sept. 23, 2003  
Reply to Office action of July 1, 2003

### Remarks

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Claims 10-23 are pending in this application.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 10-23 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over de Haut et al. (US 6,207,014). This rejection is respectfully traversed for the following reasons.

Applicant respectfully submits that the '014 reference fails to anticipate the claimed invention, for the following reason. It is extremely well settled that a factual determination of anticipation requires the disclosure, in a single reference, of each and every element of the claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, In re Levy, 17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990). It is Applicant's position that the '014 reference fails to anticipate the claimed invention on the grounds that each and every element thereof is NOT disclosed by said reference. More particularly, the '014 reference fails to disclose the use of the claimed polyol poly-12-hydroxystearate, the claimed wax component, and the claimed amount of wax ester in its emulsion composition. As a result, this reference cannot serve to anticipate the claimed invention.

As for the Examiner's obviousness rejection, Applicant respectfully submits that the '014 reference fails to contain the requisite teaching or suggestion to motivate one skilled in the art to wish to employ: (1) the claimed polyol poly-12-hydroxystearate; (2) the claimed wax component; and (3) the claimed amount of wax ester in its emulsion composition. With regards to the claimed polyol poly-12-hydroxystearate, the '014 reference teaches the

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use of an emulsifier, in general, to be merely optional. However, in the event that a routineer would choose to employ an emulsifier, this reference teaches two genus' of surfactants from which to choose, i.e., nonionic surfactants and/or amphoteric surfactants. Now, in the event that the routineer would, for some reason not evident from the disclosure of the '014 reference, choose to employ a nonionic surfactant, this reference then teaches 5 genus' of nonionic surfactants, each genus having numerous candidates from which to choose, one of which being the claimed polyol poly-12-hydroxystearate. Clearly, a lot of critical decisions would need to be made in order for the routineer to arrive at a formulation which reads on the claimed invention.

This being the case, Applicant would like to note that it is well settled that that which is within the capabilities of one skilled in the art is not synonymous with obviousness. Ex parte Gerlach, 212 USPQ 471 (Bd. Pat. App. & Inter. 1980). In Ex parte Wittpenn, 16 USPQ2d 1730 (BPAI 1990), the Examiner had rejected an applicant's claims on the grounds that all of the claimed components were disclosed in a prior art reference (Roggenkamp). In that case it was found that although the prior art contained all elements of applicant's invention, the prior art indicated no preference for any particular component of one of the elements, i.e., the nonionic surfactant. The Board there held that, "... since we have been apprised of no disclosure within the Roggenkamp reference that would have led the routineer to make the **critical** selections to arrive at the claimed surfactant composition, we find that no prima facie case of obviousness has been established and that the rejection before us cannot be sustained." *Id.* at 1731 (emphasis added). Here too, there exists **no disclosure** within the '014 reference which would motivate one skilled in the art to: (1) choose to employ an emulsifier, particularly since its use is optional and would add cost to the finished formulation; (2) choose to employ a nonionic surfactant, rather than an amphoteric surfactant; (3) choose to employ a polyol, rather than any other type of nonionic surfactant; (4) choose to employ a polyol poly-12-hydroxystearate, rather

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than any of the other numerous polyol candidates; and (5) choose to employ the polyol poly-12-hydroxystearate in the claimed amount. Consequently, this element of the claimed invention is not believed to be rendered obvious by the teaching or suggestion of the '014 reference.

The same holds true with respect to the wax component. Its use is also taught to be merely optional. If one chooses to use to substitute some of the water in the '014 formulation for an obviously more costly ingredient, then they need to then choose to decide to use either a wax component or an oil component. Here too, there exists **no disclosure** within the '014 reference which would motivate one skilled in the art to: (1) choose to use this clearly optional ingredient which will add cost to the finished formulation, rather than water; (2) and then choose to use wax rather than oil.

Finally, with respect to the amount of wax ester taught as being used in the '014 reference, while it is true that the **maximum** amount of wax ester taught for use by '014 overlaps with the claimed **minimum** amount of wax ester, other than the disclosure by the '014 reference of a maximum number (50% by weight), nowhere else within the four corners of the reference is it taught, suggested or motivated to use the maximum amount of wax ester in its formulation. On the contrary, based on the broad range regarding the amount of wax ester which may be used in its formulation (1-50%), and the lack of any other information concerning actual use/preferred amounts, the routineer would more likely than not choose to employ some amount of wax ester which is **less than** the maximum amount taught by the '014 reference. Here too, the *Ex parte Wittpenn* decision comes into play due to the lack of disclosure in this reference which would motivate the routineer to wish to employ the maximum amount of wax ester in its composition, thereby reading on the claimed invention.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

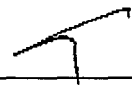
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It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,

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